

**REMARKS**

**I. Status of Claims**

Claims 1 and 8 are all the claims pending in the application, and have been amended to recite the formation of a mousse. The amendment to Claims 1 and 8 is supported at, for example, the paragraph bridging pages 5 and 6 of the specification.

No new matter is added. Accordingly, Applicants respectfully request entry and consideration of the Amendment.

**II. Response to Claim Rejection Under 35 U.S.C. § 112**

A. Claims 1 and 8 were rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the enablement requirement.

Applicants respectfully traverse, at least for the following reasons.

At page 10, line 2 - page 12, line 13, the specification provides general and specific descriptions of the container, gas propellant, and other conditions such as gas pressure. Current claim 1 recites “container comprises a gas propellant partially dissolved in said water-in-oil emulsion; the container has a discharging nozzle for discharging the emulsion with the gas propellant as a mousse form therefrom; the mousse is formed at the time of jetting.” These features, in combination with the ingredients contained therein as recited in claim 1, are fully enabled from the disclosure of the specification. The specification describes the container, gas propellant, emulsion, and etc to the extent that one skilled in the art would have been able to make and use the claimed emulsion contained in a container without undue experiment. The mere fact that Gupta’s container cannot accomplish the claimed invention does not render the claimed invention lacking enablement. Differences between the container recited in the instant

claims and the container taught by Gupta is explained in concurrently submitted executed Declaration under 37 C.F.R. § 1.132 by Mr. Tamai. As Mr. Tamai explained in the Declaration, the container taught by Gupta cannot meet receive an emulsion in a way meeting the limitations of claims of the instant application. Also, Mr. Tamai explains why the disclosure of the specification of the instant application sufficiently describes the claimed invention (emulsion and container) to enable one skilled in the art to make and use it without undue experimentation.

Therefore, one skilled in the art would have been sufficiently enabled to make and use the claimed composition combined in an aerosol container to form a mousse, in light of the disclosure of the specification and knowledge available in the art at the time of the invention was made.

In view of the above, Applicants submit that Claims 1 and 8 are enabled by the specification. Accordingly, Applicants respectfully request reconsideration and withdrawal of the § 112, first paragraph rejection of the claims.

**B.** Claims 1 and 8 are rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite.

The Examiner states that the phrase “the container has a discharging nozzle for discharging the emulsion with the gas propellant as a foam therefrom” in claim 1, lines 5-8 is vague and indefinite because it is unclear whether any valve will generate a foam with the emulsion or whether a specific type of valve required. The Examiner has requested clarification on this point.

Applicants respectfully traverse, at least for the following reason.

Present **Claim 1** is directed to the formation of a mousse upon jetting. In the present case, since the **gas is (at least) partially dissolved in the emulsion** under pressure, when the composition is jetted from the nozzle and the pressure is reduced to atmospheric pressure, the gas is vaporized from the composition to cause foaming of the composition.

For this purpose, there is no specific limitation to the type of valve, *as long as the valve adapted for the container* can discharge the emulsion and gas propellant contained in the container, when the gas is partially dissolved in the emulsion under pressure. Such valve is known in the art and can be selected by one skilled in the art.

In this regard, Applicants would like to explain why the container of Gupta does not satisfy the requirement defined in claim 1 of the instant application and fails to form a mousse. In **Gupta**, the inside of the container is divided by the piston, and the product composition fills the upper side of the piston whereas the propellant fills the lower side of the piston. See, for e.g., paragraph [0089] and Fig. 7 of Gupta. Thus, when the **container of Gupta** is used, a composition and a propellant are present **separately**, and the composition is jetted in a state where the propellant is not dissolved in the composition. Thus, at the time of jetting, the gas is not vaporized in the composition, and a mousse is not formed.

In this regard, Applicants also note that when the water-in-oil emulsion of the present invention, fills the upper chamber of the Gupta container, while a gas propellant fills the fin-separated lower chamber of the Gupta container (i.e., the gas propellant was not in contact with nor partially dissolved in the water-in-oil emulsion), a mousse is not formed. In other words, if a composition is jetted only using pressure, the composition is jetted in a form of a cord or mist depending on the shape of the nozzle, but foaming does not occur.

Accordingly, one skilled in the art, who reads the claim language in view of the disclosure of the specification would clearly understand the metes and bounds of Claims 1 and 8, and Applicants' respectfully request reconsideration and withdrawal of the § 112, second paragraph rejection of the claims.

### **III. Response to Claim Rejection Under 35 U.S.C. § 103**

Claims 1 and 8 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Gupta (U.S. Patent Application Publication No. 2003/0019888) in view of Matsuda et al. (U.S. Patent No. 5,773,073) and Hotta et al. (U.S. Patent Application Publication No. 2002/0182303).

Applicants respectfully traverse, at least for the following reasons.

Present Claim 1 recites that "the container comprises a gas propellant partially dissolved in said water-in-oil emulsion," which is required to form a mousse when the emulsion and the propellant are jetted.

In comparison, in the container of Gupta, the gas only functions to push the content out of the container. Thus, if only an emulsion exists, it is pushed out without foaming. That is, the emulsion is jetted in the form of a cord or a mist depending on the shape of the nozzle, and foam or mousse never could form. In other words, in order for the product of Gupta to be jetted in the form of a mousse, the product filled in a upper chamber of the container should already be in the form of a mousse, which is clearly distinguished from the features defined in claim 1 of the instant application.

Additionally, the jetting of a mousse in the presently claimed invention is unexpected over the invention of Gupta, as discussed in the concurrently submitted Rule 132 Declaration of Mr. Tamai. Matsuda and Hotta do not cure this deficiency in Gupta.

Accordingly, Claims 1 and 8 are patentable over the combination of Gupta, Matsuda and Hotta. Thus, Applicants respectfully request reconsideration and withdrawal of the § 103(a) rejection of the claims.

#### **Information Disclosure Statement**

Applicants concurrently file an Information Disclosure Statement to submit references mentioned in the specification, but inadvertently missed out from the IDS submitted on June 20, 2006. They include JP 2001-178364, JP 4-30748, and JP 64-086833.

Also, a copy of JP 5-132010, which is mentioned in the Mr. Tamai's Rule 132 Declaration, is submitted in the IDS along with a partial English translation of Abstract, latter part of paragraph [0010], and paragraphs [0013]-[0015] thereof.

Consideration and acknowledgement by returning an initialed SB/08 Form are respectfully requested.

#### **Conclusion**

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number **202-775-7588**.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

/Sunhee Lee/

SUGHRUE MION, PLLC  
Telephone: (202) 293-7060  
Facsimile: (202) 293-7860

WASHINGTON DC SUGHRUE/265550

**65565**

CUSTOMER NUMBER

Date: November 30, 2010

---

Sunhee Lee  
Registration No. 53,892